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[12406/115]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Brian J. ROBERTS et al.
Serial No. : 09/738,234
Filed : December 15, 2000
For : COUNTER TOP TICKET DISPENSER, DISPLAY, AND
WRITING STAND
Art Unit : 3724
Examiner : Clark F. Dexter
Confirmation No. : 2950

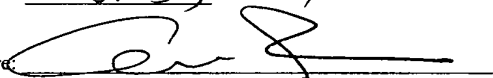
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Res. 47,893

REPLY UNDER 37 C.F.R. § 1.116

SIR:

This paper addresses the Final Office Action of September 8, 2004.

Reconsideration of the Application is respectfully requested in light of the following remarks.

REMARKS

I. Introduction

Claims 26 to 29, 31, and 41 to 44 are pending in the present application. Claim 28 has been allowed. The other claims all stand rejected. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for the indication that claim 28 is allowed.

II. Rejection of Claims 26, 27, 29, 31, and 41 to 44 Under 35 U.S.C. § 103(a)

Claims 26, 27, 29, 31, and 41 to 44 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. No. 5,492,398 ("Schafer"). It is respectfully submitted that Schafer does not render unpatentable claims 26, 27, 29, 31, and 41 to 44 for at least the following reasons.

To establish a prima facie case of obviousness, the Office Action must demonstrate three criteria: (1) there must be some suggestion or motivation to one of ordinary

skill in the art to modify a reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest each and every limitation in the claim under examination. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

Claim 26 relates to a counter and ticket display dispenser in combination.

Claim 26 recites in part:

... said housing having a flat portion for accommodating a typical bank check for said customer to write the bank check on it; ...

This feature is neither taught nor suggested by the cited Schafer reference. The feature has also not been addressed in the Office Action.

Furthermore, the combination of claim 26 also recites “said housing being mounted adjacent said counter top”. The Office Action admits that Schafer neither teaches nor suggests this claim limitation. As discussed in the previous office action response and shown in the materials regarding the Schafer ticket dispenser, Schafer is an overhead mounted device, not a countertop device. The Office Action interprets Applicant’s comment that Schafer is mounted over a counter as an admission that Schafer is adjacent the countertop. Applicant strongly disagrees. No such admission was intended or can even be reasonably construed from Applicant’s statement. To the extent the Examiner relies on Official Notice, Applicant respectfully traverses and requests an affidavit. MPEP 2144.03. To the extent the Examiner is relying on a combination with Feola, Applicant also respectfully traverses for at least the following reasons. First, the only ticket machines described in Feola are floor mounted devices, not countertop devices. A floor mounted device, by itself, does not teach the recited claim limitation. So, neither Feola nor Schafer teach the recited claim limitation. Second, no proper motivation to combine Feola with Schafer has been provided. The combination is a pure hindsight reconstruction. Moreover, Schafer’s own writings, cited in the previous office action, teach away from the proposed combination.

Furthermore, the combination of claim 26 also includes a front and rear cover.

Claim 26 recites in part:

the front and rear cover are each hingedly coupled to a remainder of the housing to open outwardly from the remainder of the housing and permit access to the inside of the housing

The Office Action admits that Schafer does not disclose a ticket dispenser with a front and a rear cover hingedly coupled to the housing. Schafer uses exit slots, not hinged covers. The Office Action relies on Official Notice for this feature, which the Applicant respectfully traverses. An affidavit is respectfully requested. *See* MPEP 2144.03.

Since no affidavit has been provided, Applicant assumes that the Examiner is instead proposing a combination with one of the references mentioned in the discussion, i.e., Tigner, Mell, or Casperson. (Applicant notes that as a formal matter, this is improper, because the stated statutory rejection relies only on Schafer. Accordingly, to preserve Applicant's future rights, Applicant respectfully requests a withdrawal of finality of the present office action and the issuance of an Office Action with a proper rejection and resetting of the times for response.)

The Office Action next discusses a combination of Schafer with U.S. Pat. No 4,738,384 ("Tigner"), U.S. Pat. No. 2,482,714 (Mell"), and/or U.S. Pat. No. 5,131,561 ("Casperson") to remedy the deficiencies of Schafer. Applicant respectfully traverses.

First, the proposed combination is not Applicant's claimed invention, because none of the cited references teach the recited feature of Applicant's invention, alone or in combination. As illustrated in figures 3 and 4 of Tigner, Tigner refers only to a single cover hingedly coupled to a housing. The cover is located only at a front side of the housing. Thus, Tigner does not disclose or suggest a ticket dispenser that includes two covers, one at a front side and a second at a rear side. Mell refers to a paper dispenser that includes an upper and a lower cover, both positioned at one side of the dispenser. Mell does not disclose or suggest a front cover facing a customer side and a rear cover facing a clerk side.

Casperson should not have been used in this rejection because it is non-analogous art with respect to the claimed invention. In order for a reference to be used against a claim in a prior art rejection, the reference must either (1) be from the same field of endeavor as Applicant's invention, or (2) if not from the same field of endeavor, be reasonably pertinent to the problem with which the Applicant is concerned. See M.P.E.P. § 2141.01(a). Applicants' invention relates to ticket dispensers; Casperson relates to napkin dispensers. They are therefore not of the same field of endeavor. Moreover, even though Casperson describes a two-sided dispenser, it does not describe a two-sided dispenser with hingedly connected front and back covers. The two sides of Casperson are not configured to face a clerk on one side

and a customer on the other. Thus, none of the references, alone or in combination, teach or suggest the recited feature of Applicant's claim 26.

Second, neither the Office Action nor the references provide a motivation to combine the references. Simply citing "well known benefits" is strong evidence of an improper hindsight reconstruction. In fact, the references actually teach away from the proposed combination. Casperson indicates that two doors are provided so that "persons at different positions around a table can readily remove a napkin from the dispenser." Schafer indicates that the dispenser is to be structured to prohibit free and easy access to all. Schafer's dispenser is to be structured to allow for limited access only to authorized persons, for example a clerk at a rear side of the dispenser. Thus, Schafer and Casperson actually teach away from the proposed combination.

For at least these reasons, Schafer, whether alone or in combination with any of Tigner, Mell, and/or Casperson does not disclose or suggest all of the limitations of Applicant's claim 26. It is therefore respectfully submitted that Schafer does not render unpatentable Applicant's claim 26.

Claims 27, 29, 31, and 41 to 44 ultimately depend from and therefore include all of the limitations of claim 26. It is therefore respectfully submitted that Schafer does not render unpatentable these dependent claims for the same reasons set forth in support of the patentability of claim 26. In re Fine, 837 F.2d 1071 (Fed. Cir. 1988) (any dependent claim that depends from a non-obvious independent claim is non-obvious).

Moreover, with respect to claims 41-43, the Office Action relied on Official Notice that arcuate dispenser covers are old and well known. Applicant respectfully traverses and requests an affidavit. MPEP 2144.03. To the extent the Examiner is actually relying on a combination with West or Mell, Applicant traverses because no proper motivation to combine the alleged arcuate dispenser cover with Schafer, the base reference, has been provided. Simply citing "well known benefits" is again evidence this is a hindsight reconstruction. To reject, the Examiner must find a suggestion to combine the references that is "clear and particular". *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). Moreover, none of the references cited has a combination of both an arcuate cover and a flat surface for check writing for a ticket dispenser, as recited in Applicant's claims. Moreover, claims 41 and 42 recite that the arcuate cover guides the ticket towards the outlet, while claims 42 and 43 recite that the cover is transparent. These features are not discussed in the Office Action. Applicant respectfully submits they are not taught by the proposed combination of references.

Similarly, the countertop dispenser of claim 44 has not been addressed in the office action, is not taught by any of the proposed combinations of references. Withdrawal of the rejections of claims 41-44 is respectfully requested for at least these additional reasons.

III. Conclusion

Applicants respectfully submit that all of the pending claims of the present application are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,
KENYON & KENYON

Dated: Nov. 5, 2004

By:

A handwritten signature in black ink, appearing to read 'Andrew L. Reibman', written over a horizontal line.

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